

Appl. No. 10/508,745; Docket No. NL02 0251US
Amdt. dated December 21, 2005
Reply to Office Action of November 30, 2005

REMARKS/ARGUMENTS

Claims 1-7 are pending in the application.

Drawings are objected to under 37 CFR 1.83(a). Claim 4 is objected to owing to informalities.

Claims 1-7 are rejected under 35 U.S.C. §102(b) as being anticipated by Davis (US 6,137,173) hereinafter *Davis*.

The Drawing Objections

With respect to the drawings, the Applicants respectfully traverse the objections. The feature "security layer is present at the second side of the substrate. . ." With respect to this feature, "Nevertheless, a security layer can be provided at the second side of the substrate, which security layer leaves exposed the bond pad regions or any metallisation for access thereto. This option can be used with silicon or other semiconductor substrates. It is however in particular preferred in the case that the transistors are of the thin-film type that are preferably present on an insulating substrate. Such a structure may have the advantage of flexibility, and is therefore very suitable for integration in flexible carriers, such as banknotes, other security papers, labels and tags. Further on, in the case of an insulating substrate with thin film transistors, the insulating substrate can be or contain a security layer or could be replaced by a security layer after processing if so desired (Specification , page 4, paragraph 3)." One reasonably skilled in the art can infer as to the construction of this additional embodiment from the current slate of figures.

With respect to "antiprobe means," the feature is supported in the Specification. "Although it might appear at first sight that the semiconductor device of the invention is at its second side open to probing and to detect any structures, this is not true or the problem can be solved. First of all, the bond pads can be protected by antiprobng means. This is not different from the prior art situation. Such antiprobng means can be of a software nature, a hardware nature or a combined hardware/software nature. For example, it can be prescribed that a signal should have a specific pattern and alternatively is directly connected to a ground plane (Specification, page 3, paragraph 4)." Upon

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review of the regulation 37 CFR §1.83(a), this antiprobng feature *does* not admit by way of illustration.

Therefore, a drawing is not necessary for the subject matter of antiprobng feature and security feature on the second side of the substrate sought to be patented. The rule reads,

- (a) The applicant for a patent is required to furnish a drawing of his or her invention where necessary for the understanding of the subject matter sought to be patented; this drawing, or a high quality copy thereof, must be filed with the application. Since corrections are the responsibility of the applicant, the original drawing(s) should be retained by the applicant for any necessary future correction.

Applicants respectfully ask that the drawing objections be withdrawn, in that a drawing is not necessary in this instance.

Claim Objection

Per Examiner's observation, claim 4 has been amended to correct informalities.

Claim Rejections

Claims 1-7 are rejected under 35 U.S.C. §102(b) as being anticipated by Davis (US 6,137,173) hereinafter *Davis*.

Applicants respectfully traverse the §102 rejections. The Office Action concedes that, "Davis does not limit his security coating to any particular material (Office Action page 4, lines 8-9)." However, the claimed feature of, "the protective security covering comprises a substantially non-transparent and substantially chemically-inert security coating," is *not* disclosed. Consequently, *Davis* does not anticipate Applicants' invention.

Per MPEP §2131:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently describe in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628,631,2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

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The Office Action's assertion that "Davis's disclosure encompasses all well-known security coating materials, including substantially non-transparent materials," is insufficient rationale. Per MPEP §2112, IV,

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

Based upon the lack of anticipation of Davis and the insufficient showing of inherency, Applicants request that the §102 rejections be withdrawn. Claim 1 is therefore allowable and dependent claims 2-7 are also allowable.

Conclusion

Applicants believe they have addressed all of the Examiner's concerns. In that the claims are allowable, a Notice of Allowance is earnestly requested.

Please charge any fees other than the issue fee and credit any overpayments to Deposit Account 14-1270.

Respectfully submitted,

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